

REMARKS

Applicants have used the status identifier “Withdrawn-currently amended” to reflect amendments to withdrawn claim 21. Applicants note that 37 C.F.R. 1.121 and M.P.E.P. § 714 list “Original,” “Currently amended,” “Canceled,” “Withdrawn,” “Previously presented,” “New,” and “Not entered” as the status identifiers to be used to indicate the status of the claims and that subsection C(E) of M.P.E.P. § 714 lists “Withdrawn-currently amended” as an acceptable alternative for “Withdrawn.”

Claims 7, 14, and 21 have each been amended to recite the transitional phrase “consisting of.” Claims 23 and 24 have been canceled without prejudice or disclaimer. Support for new claims 25 through 29 is found in the as-filed specification at at least paragraphs [0028]-[0034], [0070], [0079], and [0081].

The Office Action mailed December 21, 2007, has been received and reviewed. Claims 7, 14, and 20 through 24 are currently pending in the application. Claims 21 and 22 have been withdrawn from consideration as being drawn to a non-elected invention. Claims 7, 14, 20, 23, and 24 stand rejected.

Applicant has amended claims 7, 14 and 21, canceled claims 23 and 24 and added new claims 25 through 29 and respectfully request reconsideration of the application as amended herein.

Claim Objections

Claims 23 and 24 are objected to due to informalities in the claim language. Each of claims 23 and 24 has been canceled, rendering moot this objection.

35 U.S.C. § 112 Claim Rejections

Claims 23 and 24 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 23 and 24 have been canceled, rendering the rejection under 35 U.S.C. § 112 moot.

35 U.S.C. § 103(a) Obviousness Rejections

Obviousness Rejection Based on U.S. Patent No. 4,878,431 to Herring, in View of U.S. Patent No. 4,246,359 to Whelan.

Claims 7, 14, and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,878,431 to Herring (“Herring”), in view of U.S. Patent No. 4,246,359 to Whelan (“Whelan”). Applicant respectfully traverses this rejection, as hereinafter set forth.

To establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Royka*, 490 F.2d 981, 985 (CCPA 1974); *see also* MPEP § 2143.03. Additionally, the Examiner must determine whether there is “an apparent reason to combine the known elements in the fashion claimed by the patent at issue.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1740-1741, 167 L.Ed.2d 705, 75 USLW 4289, 82 U.S.P.Q.2d 1385 (2007). Further, rejections on obviousness grounds “cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id* at 1741, quoting *In re Kahn*, 441, F.3d 977, 988 (Fed. Cir. 2006). Finally, to establish a *prima facie* case of obviousness there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). Furthermore, the reason that would have prompted the combination and the reasonable expectation of success must be found in the prior art, common knowledge, or the nature of the problem itself, and not based on the Applicant’s disclosure. *DyStar Textilfarben GmbH & Co. Deutschland KG v. C. H. Patrick Co.*, 464 F.3d 1356, 1367 (Fed. Cir. 2006); MPEP § 2144. Underlying the obvious determination is the fact that statutorily prohibited hindsight cannot be used. *KSR*, 127 S.Ct. at 1742; *DyStar*, 464 F.3d at 1367.

The 35 U.S.C. § 103(a) obviousness rejection of claims 7, 14, and 20 is improper because the applied references themselves, or the inferences and creative steps that a person of ordinary skill in the art would have employed at the time of the invention, do not teach or suggest the claim limitations. In addition, the applied references, the common knowledge, or the nature of the problem itself do not provide a reason that would have prompted combination of the applied references in the asserted manner. Furthermore, even if Herring and Whelan were combined, the claimed invention would not be produced.

Herring teaches an elastomeric insulation material. Herring at column 1, lines 11-14.

The elastomeric insulation material includes an elastomeric polymer, such as polychloroprene, chlorosulfonated polyethylene, polyurethane, and ethylene propylene diene monomer (“EPDM”).

Id. at column 3, lines 22-28. The elastomeric insulation material also includes char-forming organic fibers and inorganic particulates. *Id.* at column 2, lines 38-41 and column 3, lines 62-68.

The char-forming organic fibers are polyaramide pulp fibers. *Id.* The inorganic particulates include hydrated silica, mica, or quartz. *Id.* To improve flame retardance, the elastomeric insulation material also includes chlorinated organic compounds in combination with antimony oxide or hydrated alumina. *Id.* at column 4, lines 3-14.

Whelan teaches fire retardant compositions including hydrocarbon dienes and a synergistic, three-component flame retardant. Whelan at the Abstract. The flame retardant of Whelan includes a synergistic combination of a halogenated organic compound, alumina hydrate and an iron oxide. *Id.* at column 1, lines 43-45. The halogenated organic compound is a chlorine or bromine substituted compound, such as polyvinyl chloride. *Id.* at column 3, lines 20-25.

Independent claims 7 and 14, as amended herein, each recite, *inter alia*, “an insulation material consisting of a low-density ethylene propylene diene monomer polymer, at least one flame retardant, sulfur, an organic filler selected from the group consisting of polyvinyl chloride, melamine, and a homopolymer of vinylidene chloride, and at least one additive selected from the group consisting of at least one antioxidant, at least one cure accelerator, at least one cure activator, at least one tackifier, and at least one plasticizer.”

It is respectfully submitted that the applied references do not teach or suggest all the limitations of claims 7 and 14 because Herring and Whelan, alone or in combination, do not teach or suggest an insulation material consisting of the components recited in claims 7 and 14. Applicant notes that the transitional phrase “consisting of,” as recited in claims 7 and 14, excludes any elements or ingredients not specified in the claims. See M.P.E.P. § 2111.03.

Rather, the elastomeric insulation material of Herring includes EPDM, polyaramide pulp fibers, inorganic particulates, and chlorinated organic compounds in combination with antimony oxide or hydrated alumina. Since the elastomeric insulation material of Herring includes additional components, such as polyaramide pulp fibers, inorganic particulates and chlorinated organic compounds in combination with antimony oxide or hydrated alumina, Herring does not teach or

suggest a material that consists of the components recited in claims 7 and 14. Whelan teaches a three-component flame retardant system that is added to a composition including a hydrocarbon diene and, thus, also does not teach or suggest the above-mentioned limitation.

As acknowledged by the Examiner, Herring does not teach or suggest the organic fillers recited in claims 7 and 14. Therefore, the Examiner relies on Whelan as teaching “chlorine-containing polymers, e.g. polyvinyl chloride.” *See* Office Action of December 21, 2007, p. 3. The Examiner asserts that the chlorinated compounds of Whelan could be used in the elastomeric insulation material of Herring. *Id.* at p. 4. However, Whelan teaches a synergistic flame retardant system that includes three components, namely, a chlorine- or bromine-containing additive, alumina trihydrate and an iron oxide. Each of the examples provided in Whelan teaches a composition combined with this three-component flame retardant system. Nothing in Whelan teaches or suggests utilizing the halogenated organic compound in the absence of the alumina trihydrate and the iron oxide. Rather, Whelan teaches that the combination of all three components provides an unexpectedly high degree of flame-resistance.

It is further submitted that, without the benefit of hindsight, there is no reason in the applied references, common knowledge, or the nature of the problem itself that would have prompted a person of ordinary skill in the art to combine elements of Herring and Whelan in the asserted manner. The Examiner asserts that “it would have been obvious to one of ordinary skill in the art to utilize an appropriate chlorinated compound in Herring, including those polymeric compounds within the scope of the present claims, and thereby arrive at the presently recited claims.” *Id.* However, as explained above, Whelan teaches a three-component flame retardant system that includes a chlorine substituted compound, alumina trihydrate and an iron oxide. Whelan teaches that the components of the flame retardant, in combination, enhance the effects of one another to provide the flame-resistance characteristic. Aside from these teachings of Whelan, the Examiner has not provided any reasoning that one of ordinary skill in the art would have been prompted to make the asserted combination. Thus, Applicant respectfully submits that one of ordinary skill in the art would not have been motivated to utilize polyvinyl chloride in the composition of Herring without also using alumina trihydrate and iron oxide.

As such, even if Herring and Whelan were combined in the manner asserted, the claimed invention would not be produced because the resulting composition would additionally include

iron oxide and alumina trihydrate. Accordingly, Whelan cannot cure the deficiencies of Herring because the combination of Whelan and Herring does not result in an insulation material that consists of the components recited in claims 7 and 14.

Thus, it is respectfully submitted that a *prima facie* case of obviousness has not been established against either of amended independent claims 7 and 14.

Claim 20 is allowable, *inter alia*, as depending from an allowable base claim.

Therefore, withdrawal of the 35 U.S.C. § 103(a) rejection of claims 7, 14, and 20 is respectfully solicited, as is the allowance of each of these claims.

New claims 25 through 29 are each allowable as none of the applied references teaches or suggests “polyvinyl chloride fibers having a density of 1.38 g/cc.”

Obviousness Rejection Based on Herring, in View of Whelan, and Further in View of U.S. Patent No. 5,821,284 to Graham et al.

Claims 23 and 24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Herring, in view of Whelan, and further in view of U.S. Patent No. 5,821,284 Graham et al. (“Graham”).

The rejection of claims 23 and 24 is moot, as each of claims 23 and 24 has been canceled.

ENTRY OF AMENDMENTS

The amendments to claims 7, 14 and 21 and new claims 25 through 29 should be entered by the Examiner because the amendments are supported by the as-filed specification and drawings and do not add any new matter to the application.

It is respectfully submitted that independent claims 7 and 14 are generic to all of the species of invention that were identified in the Election of Species Requirement in the above-referenced application. In view of the allowability of these claims, claims 21 and 22 which have been withdrawn from consideration, should be considered and allowed. M.P.E.P. § 806.04(d).

CONCLUSION

Claims 7, 14, 20 through 22, and 25 through 29 are believed to be in condition for allowance, and an early notice thereof is respectfully solicited. Should the Examiner determine that additional issues remain which might be resolved by a telephone conference, the Examiner is respectfully invited to contact Applicant's undersigned attorney.

Respectfully submitted,



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